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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,941	02/22/2000	Masato Ochiai	35.C14278	2960

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NEW YORK, NY 10112

EXAMINER
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ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/507,941

Applicant(s)

OCHIAI, MASATO

Examiner

David E. England

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 6, 8 - 10, 12, 13, 15, 17, 19 - 21, 34 and 45 - 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6, 8 - 10, 12, 13, 15, 17, 19 - 21, 34 and 45 - 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Claims 1, 2, 4, 6, 8 – 10, 12, 13, 15, 17, 19 – 21, 34 and 45 – 49 are presented for examination.

#### *Claim Rejections - 35 USC § 102*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, 4, 5, 12, 13, 15, 34 and 47 – 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Beser U.S. Patent No. 6189102.

4. Referencing claim 1, as interpreted by the Examiner, Beser teaches a network apparatus comprising:

5. a receiving unit adapted to receive data from a network by using a predetermined protocol, (e.g. col. 14, line 38 – col. 16, line 35);

6. a detecting unit adapted to receive a predetermined value in a packet header of the data received by said receiving unit, the packet header being provided for the predetermined protocol, (e.g. col. 14, line 38 – col. 16, line 35, “HOPS 116, XID 118, FLAGS 122, TLV”); and

7. a setting unit adapted to set a destination logic address of the received data as a logic address of said network apparatus in a case where the predetermined value is detected by said

Art Unit: 2143

detecting unit and a destination physical address of the received data and a physical address of said network apparatus are the same, (e.g. col. 14, line 38 – col. 16, line 35, “*BOOTP*”).

8. Referencing claim 2, as interpreted by the Examiner, Beser teaches in a case where the destination logic address of the received data and the logic address of said network apparatus differ, the destination physical address of the received data and the physical address of said network apparatus are the same, and the predetermined value is detected by said detecting unit, said setting unit sets the destination logic address of the received data as logic address of said network, (e.g. col. 14, line 38 – col. 16, line 35, “*BOOTP*”).

9. Referencing claim 4, Beser said physical address is a media access control address, and the logic address is an Internet protocol address, (e.g. col. 14, line 38 – col. 16, line 35 & col. 18, line 49 – col. 19, line 16).

10. Claims 12, 13, 15, 34 and 47 – 49 are rejected for similar reasons as stated above.

11. Claims 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Nixon et al. U.S. Patent No. 6266726 (hereinafter Nixon).

12. Referencing claim 45, Nixon teaches a network apparatus comprising:

13. a receiving unit adapted to receive data from a network by using a predetermined protocol, (e.g. col. 25, lines 31 – 55, “*Cards, Ports and devices*”);

Art Unit: 2143

14. a detecting unit adapted to receive a predetermined value in a packet header of the data received by said receiving unit, the packet header being provided for the predetermined protocol; (e.g. col. 26, line 24 – col. 27, line18, “*UDP datagram*”); and

15. a setting unit adapted to set a factory-based value in a case where the predetermined value is detected by said detecting unit and a destination physical address of the received data and a physical address of the network apparatus are the same, (e.g. col. 26, line 24 – col. 27, line18, “*UDP datagram, default primary address*”).

16. Reverencing claim 46, Nixon teaches said setting unit sets the factory-based value if the destination physical address of the received data and the physical address of said network apparatus are the same and the predetermined value is detected by said detecting unit, (e.g. col. 26, line 24 – col. 27, line18, “*UDP datagram, default primary address*”).

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 6, 8 – 10, 17 and 19 – 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beser (6189102) in view of Anderson et al. (5850388) (hereinafter Anderson).

19. Referencing claim 6, Beser does not specifically teach the received data is an ICMP echo message by an ICMP protocol and the predetermined value indicates a data length of the ICMP echo message. Anderson teaches the received data is an ICMP echo message by an ICMP protocol and the predetermined value indicates a data length of the ICMP echo message, (e.g. col. 12, lines 22 – 56 & col. 20, line 54 – col. 21, line 30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Anderson with Beser because it would be more efficient for a system to not have to shut down an end system and turn back on to receive a new IP address as with the functionality of BOOTP. Using an ICMP echo would allow a user to keep the end system on and receive a new IP address with out the burden of turning the end system off. Furthermore, utilizing a data length, sometimes known as a “checksum” or “CRC”, allows the end system to check for errors in the packet if the data length is not to a predetermined length.

20. As per claim 8, Beser does not teach the predetermined value indicates a TTL value of the received data. Anderson teaches the predetermined value indicates a TTL value of the received data, (e.g. col. 21, line 59 – col. 22, line 24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Anderson with Beser because it is more efficient for a packet to have a TTL field in a packet so if the packet is taking too long to be transmitted through the Internet the packet could be dropped and aid in congestion control in a network.

Art Unit: 2143

21. Claims 9, 10, 17 and 19 – 21 are rejected for similar reasons stated above.

***Response to Arguments***

22. Applicant's arguments filed 08/13/2004 have been fully considered but they are not persuasive.

23. In the remarks, Applicant argues in substance that nothing has been found in Beser that would teach or suggest setting the destination logic address of the received data as the logic address of the network apparatus in a case where (a) the predetermined value is detected by the detecting unit and (b) a destination physical address of the received data and a physical address of the network apparatus are the same, as recited in Claim 1.

24. As for part 1, Examiner would like to draw the Applicant's attention to the claim language of claim 1. In which the Applicant does not specifically define in the claim what the "predetermined value", "detecting unit" and "setting unit". Furthermore, the claim language does not specifically state what or where the destination or source address is coming from and what device the physical and logic addresses are addressed to, which would make it ambiguous as to if the device that is receiving the packet is the destination or, the source of the packet that is responding to an acknowledgement from another device or setting the logic address from a response to a query. The Applicant is advised to look over the RFC-951 and PFC-1542 the Beser has incorporated as a reference in the section the Examiner has cited, which states "This RFC

Art Unit: 2143

describes an IP/UDP bootstrap protocol (BOOTP) which allows a diskless client machine to discover its own IP address". Therefore, the act of having the BOOTP protocol set the IP address of a device from the physical address that is in a database reads on the claim language.

25. In the remarks, Applicant argues in substance that nothing has been found in Anderson et al. that would teach or suggest setting a destination IP address of the received ICMP echo message as an IP address of the network apparatus if (a) the data length has a specific value and (b) a destination MAC address if the received ICMP echo message and a MAC address of the apparatus are the same, as recited in Claim 9.

26. As for part 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

27. Examiner would also like to draw the Applicant's attention to the above reasoning in part one of the Examiner's Response to Arguments. In which the same language appears in claim 9 and for the same reasoning claim 9 is still rejected for reasons stated above. Furthermore, the Applicant does not state in the claim language of claim 9 where or what the data length is suppose to be or which part of the packet the data length is suppose to be, (i.e. it could be the CRC which is the check sum of the packet, which is well known in the art that if the CRC does not have a specific number in it the data packet does not add up correctly which could mean that the data length has an error and the packet is bad.



Art Unit: 2143

28. In the remarks, Applicant argues in substance that nothing has been found in Nixon et al. that would teach or suggest a network apparatus setting a factory-based value in a case where (a) the predetermined value is detected by the detecting unit and (b) a destination physical address of the received data and a physical address of the network apparatus are the same, as recited in Claim 45.

29. As for part 3, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

30. The Examiner would like to draw the Applicant's attention to the above responses to the Applicant's remarks which all have similar claim language and issues that are incorporated herein as reference. The Reference of Nixon teaches a MAC address, which it is well known in the art that at the time of manufacture, a MAC address can be set on a network device as a backup address if the device has not yet been installed into a network and does not have an IP address. Therefore, with the above responses to Applicant's arguments, Nixon reads on the Applicant's broad claim language.

### ***Conclusion***

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

32. Bill Croft, Internet RFC/STD/FYI/BCP Archives, <http://www.faqs.org/rfcs/>, September 1985, RFC 951.

Art Unit: 2143

33. W. Wimer, Internet RFC/STD/FYI/BCP Archives, <http://www.faqs.org/rfcs/>, October 1993, RFC 1532.
34. W. Wimer, Internet RFC/STD/FYI/BCP Archives, <http://www.faqs.org/rfcs/>, October 1993 RFC 1542.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
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Art Unit 2143

De



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